

REMARKS

The specification has been amended to insert a brief description of new Figures 2 and 3 and to delete pages 16 and 17.

Claim 8 has been amended to restrict the claim to the elected invention, namely an agent that modulates gene expression of the NPY gene having the specified polymorphism in which the agent is an oligonucleotide. Support for this amendment can be found at page 7, line 12 - page 8, line 24 of the specification. New claims 14 and 15 have been added to specify the oligonucleotide as an antisense oligonucleotide or a ribozyme, respectively. Support for these new claims can be found at page 7, line 12 - page 8, line 24 of the specification.

New Figures 2 and 3 have been added to replace Schemes 1 and 2 found on pages 16 and 17 of the specification.

It is submitted that none of the above amendments are new matter and their entry is requested.

On page 2 of the Office Action, the Examiner noted that Applicants claimed priority to an application filed in Finland on 29 March 2000 but had not provided a certified copy of the PCT application as required under 35 U.S.C. § 119(b). Applicants note that the present application is a 371 filing of the PCT application and does not claim priority to the PCT application under 35 U.S.C. § 119. Thus, it is not necessary to submit a certified copy of the PCT application. Applicants claim priority under 35 U.S.C. § 365 to a prior filed U.S. application, a certified copy of which was provided by WIPO in the international phase.

The Examiner objected to the specification for the inclusion of Schemes 1 and 2 on pages 16 and 17. These pages have been deleted by this amendment and replaced by new Figures 2 and 3. This amendment obviates this objection and its withdrawal is requested.

The Examiner objected to claims 8-10 for encompassing non-elected subject matter. The amendment of claim 8 and the cancellation of claims 9 and 10 obviate this rejection and its withdrawal is requested.

The Examiner has rejected claims 8-10 under 35 U.S.C. § 112, first paragraph for lack of written description. It is submitted that the Examiner is in error in this rejection.

Specifically, Applicants note that the majority of the Examiner's comments concerning written description are directed to the non-elected subject matter, i.e., gene therapy and agents that interact with specific NPY receptors. This non-elected subject matter has been canceled from the claims under examination. The cancellation of this subject matter thus obviates the rejection. The specification clearly describes the use of oligonucleotides, e.g., antisense oligonucleotides and ribozymes, for modulating gene expression of the mutated NPY gene. The specification further describes that these oligonucleotides are based on the sequence of the mutated NPY gene. See page 7, line 12 - page 8, line 24. Thus, it is submitted that the specification demonstrates that Applicants were in possession of the presently claimed invention at the time the application was filed.

In view of the above remarks, it is submitted that the claims comply with the written description requirement of 35 U.S.C. § 112, first paragraph. Withdrawal of this rejection is requested.

The Examiner has rejected claims 8-10 under 35 U.S.C. § 112, first paragraph for lack of enablement. It is submitted that the Examiner is in error in this rejection.

Specifically, Applicants note that the majority of the Examiner's comments concerning written description are directed to the non-elected subject matter, i.e., gene therapy and agents that interact with specific NPY receptors. This non-elected subject matter has been canceled from the claims under examination. The cancellation of this subject matter thus obviates the rejection. The specification clearly describes the use of oligonucleotides, e.g., antisense oligonucleotides and ribozymes, for modulating gene expression of the mutated NPY gene. The specification further describes that these oligonucleotides are based on the sequence of the mutated NPY gene. See page 7, line 12 - page 8, line 24. The Examiner has not provided any analysis specific to the elected subject matter and has not provided scientific reasons to doubt the objective enablement of the presently claimed subject matter as required by *In re Marzocchi*, 169 USPQ 367 (CCPA 1973) and *In re Wright*, 27 USPQ 2d, 1510 (Fed. Cir. 1993). Thus, it is submitted that the specification fully enables the presently claimed subject matter.

In view of the above remarks, it is submitted that the claims comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. Withdrawal of this rejection is requested.

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In view of the above amendments and remarks, it is submitted that the claims satisfy the requirements of the patent statutes and are patentable over the prior art. Reconsideration of the instant application and early notice of allowance are requested. The Examiner is invited to telephone the undersigned if it is deemed to expedite allowance of the application.

Respectfully submitted,

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By



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Attachments: New Figures 2 and 3

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